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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,513	11/09/1999	JOHN BRYAN JONES	3290.007US1	6754

7590 01/17/2003

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EXAMINER

PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 01/17/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/436,513

Applicant(s)

JONES ET AL.

Examiner

Charles L. Patterson, Jr.

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED**FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.**

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 December 1899. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-11, 13, 51-57, 59, 61 and 62.Claim(s) withdrawn from consideration: 21-50.

8. ☒ The proposed drawing correction filed on 03 December 2002 is a) ☐ approved or b) ☒ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet

Atch - 740948

CP Patterson
Charles L. Patterson, Jr.
Primary Examiner
Art Unit: 1652

Continuation of 5. does NOT place the application in condition for allowance because: Applicants argue that the importance of the amidase/esterase ratio is taught on page 18, lines 19-20. Applicants are apparently referring to the previous specification and that recitation is contained in the substitute specification submitted on page 19, lines 4-5. A re-reading of this section of the specification does not find anything as to the importance of this ratio. Applicants further argue that the specification teaches how to make the claimed invention and it is enabled. The rejection was based on the specification not teaching how to use the invention within the scope of the instant claims and this is maintained. The 103 rejection is also maintained for the reasons of record. Also, on page 5266, first full paragraph of Berglund, et al. (C2)), it is stated that "[t]he opportunities for generating catalysts with other improved properties, such as changed specificities and stabilities, are self-evident". As stated previously, the use of a chiral substituent in the altered cysteine site within the scope of the instant claims would be expected to alter the enzyme in a manner related to this chirality. This would be "improved properties, such as changed specificities". Therefore it is maintained that claims of the instant scope would have been obvious.

Continuation of 10. Other: Please note that the PTO-1449 has not been initialed but has been crossed out. Applicants stated in the certification that "No item of...[the IDS] was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of this" IDS. This is apparently a false statement as the first two paragraphs on page 2 of the specification disclose 5 references on the 1449, namely Bell, et al. (7), Gron, et al. (C35), Peterson, et al. (C68), Suckling, et al. (C96 and Wu, et al. (C107). The examiner has not bothered to examine the specification for further references..